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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/708,605	03/15/2004	Gregory Kaufman	KAU1	2604
23699	7590	06/07/2005	EXAMINER	
CLAUSEN MILLER, P.C			CHIN, PAUL T	
SUITE 1600			ART UNIT	PAPER NUMBER
10S. LASALLE STREET				
CHICAGO, IL 60603			3652	

DATE MAILED: 06/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/708,605	KAUFMAN ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	PAUL T. CHIN	3652

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 20 December 2004 and 21 March 2005.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-11 is/are pending in the application.  
 4a) Of the above claim(s) 6-9 and 11 is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-5 and 10 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 15 March 2004 is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

1. Applicant's amendment filed December 20, 2004, and the arguments presented therewith have been fully considered. Regarding Szillage, the argument is persuasive. Therefore, the rejection has been withdrawn. However, the argument on Herzfeld et al. is not persuasive. Moreover, upon further consideration, a new ground(s) of rejection is made. A non-final office action follows as below.

### *Election/Restrictions*

2. Applicant's election of the species of Figs. 1-5, readable on claims 1-5 and 10, in the reply filed on March 21, 2005, is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

3. Claims 5-9 and 11 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected election of species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on March 21, 2005.

### *Claim Rejections - 35 USC § 102*

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-4 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Herzfeld et al. (6,254,154) (see PTO-892).

Herzfeld et al. (6,254,154) discloses a shovel and method comprising a blade (18,32) having a leading edge to contact the surface or debris, a main handle (12), and a pivot

auxiliary handle (22,26,42,38) being attached to the blade near the leading edge (particularly the upper leading edge). The reference further shows a u-shaped member (28,28).

6. Claims 1,2, and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Collins (1,183,277).

Collins (1,183,277) discloses a shovel and method comprising a blade (6) having a leading edge to contact the surface or debris, a main handle (1), and an auxiliary handle (9-13) attached to the blade near the leading edge.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Herzfeld et al. (6,254,154) in view of Kegan, Sr. (6,203,081).

Herzfeld et al. (6,254,154), as presented in section 5 above, does not show a *secondary horizontal member or a cross bar*. However, Kegan, Sr. (6,203,081) shows a *secondary horizontal member or a cross bar* (33) to strengthen a U-shaped member. Accordingly, it would have been an obvious to one of the ordinary skill in the art at the time the invention was made to provide a *secondary horizontal member or a cross bar* on the U-shape member of Szillage (2,728,598) or Herzfeld et al. (6,254,154) as taught by Kegan Sr. (6,203,081) providing a stronger and stiffer blade.

***Response to Arguments***

9. Applicant's amendment filed December 20, 2004, and the arguments presented therewith have been fully considered. Regarding Szillage, the argument is persuasive. Therefore, the rejection has been withdrawn.

However, the argument on Herzfeld et al. is not persuasive. Note that applicant recites a phrase "near the leading edge" (claim 1, line 7). The meanings of the word "near" are defined as "to, at, or within a short distance in space or time; just about; almost; nearly" according to The American Heritage Dictionary of the English Language, Third Edition. Herzfeld et al. shows that the auxiliary handle is pivotally attached to the blade "near" the "leading edge".

In response to applicant's argument that "Herzfeld et al. is not for clearing a surface", a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PAUL T. CHIN whose telephone number is (571) 272-6922. The examiner can normally be reached on MON-THURS (7:30 -6:00 PM).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, EILEEN LILLIS can be reached on (571) 272-6928. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



PAUL T. CHIN  
Examiner  
Art Unit 3652